REMARKS/ARGUMENTS

Claims 1-4, 7-9, 11-14, 17-29, 21-24, 26-29, 32-34 and 36-38 have been rejected under

35 USC 103(a) as being unpatentable over Holman (USP 5,287,181) in view of Matheny (USP

6,766,524). Claims 5, 6, 15, 16, 30 and 31 have been rejected under 35 USC 103(a) as being

unpatentable over Holman in view of Matheny, and further in view of Kitsukawa (USP

6,282,713). Reconsideration and withdrawal of these rejections are respectfully requested in

light of the following remarks.

Summary of subject matter disclosed in the specification

The present application discloses a technique for broadcasting a programming signal,

such as for a television show, together with a program-related data signal that can be used, for

example, to print a reward interactively with watching the program. The reward can be, for

example, a discount coupon for purchasing a product advertised as part of the programming

signal.

Paragraph [0018] of the published application describes that:

> "In accordance with a key aspect of the present invention, the reward data
> signal 7 includes all of the data specific to the particular reward coupon that is
> required to print it. Such data includes, for example, the text, font, formatting,
> symbols, background color, font color, and the like. All of this data is included in
> a reward data signal 7, is combined with programming signal 5, and is transmitted
> along with the programming signal as part of output signal 2."

Although this approach is advantageous and valuable, paragraph [0025] explains that "the

addition of reward data signal 7 to programming signal 5 adds to the data transmission burdens

both at the transmitting end and the receiving end." The description goes on to explain that "it

may be advantageous to limit the amount of additional data that needs to be broadcast due to the

inclusion of the reward data signal in output signal 2." How is this to be done? The answer

can be found in paragraph 25 where it is explained as follows:

> "One way of doing so is to permanently store at the viewer's location
> some of the reward data that is required to print a reward coupon and which
> is common to all interactively available rewards. This data is stored in
> memory 39. Thus, the common reward printing data is stored in memory 39,
> whereas only the data specific to one reward is broadcast as part of output
> signal 2.

Thus, a key point to remember is that insofar as the reward data is concerned, part of that

data is permanently stored at the viewer's location and only a part of it is broadcast together with

the programming signal.

Descriptive summary of the prior art

Holman discloses a technique which provides an electronic redeemable coupon. The

coupon, referred to as "message information", is disclosed by Holman as being transmitted in its

entirety together with the television signal. See, for example, column 9, lines 10-32.

Matheny discloses a technique which offers viewers an incentive to watch a television

program which involves having the viewer answer a question correctly in order to ensure that the

viewer actually did watch the subject program. In connection with this technique, Matheny

flashes reward notice 260 and reward query 275 on the screen. As one approach to effect a

display of reward notice 260, for example, Matheny discloses transmitting it in the VBI of a

broadcast video signal (see col. 4, lines 32-34). As another approach, Matheny stores a reward

template in local memory in set-top box 245 (see col. 4, lines 49-52). A reward trigger is

transmitted which identifies the locally stored reward template and causes it to be displayed as desired.

Patentability of independent claims over the applied references

On page 4 of the Office Action, the Examiner concedes that Holman does not disclose several of the limitations recited in, for example, claim 1 of the present application. However, in the paragraphs spaning pages 4 and 5 of the Office Action, the Examiner contends that all of these elements missing from Holman are disclosed by Matheny. Furthermore, it would be obvious to "add the common and specific data taught by Matheny to the method disclosed by Holman. The motivation would have been to allow for flashier advertisements, by storing the common information on the STB, to get the user to viewer to view the advertisements (Matheny: col. 1, lines 65-67)."

The Examiner identifies the "common output data" as being disclosed in col. 2, lines 50-55. However, this portion of Matheny refers to Web pages that may "be received for video signal 210 or retrieved from a local memory". This has nothing to do with signals 260 and 275.

The Examiner also points to col. 4, lines 49-52 as disclosing the common output data. This portion of Matheny refers to storing the reward templates in local memory. More will be said about this shortly.

The Examiner points to col. 3, lines 59-62 as disclosing the specific output data. This portion of Matheny refers to "contents of log file 271 [that] are eventually pushed to remote information store 220." It is not clear what role the Examiner sees in this data of log file 271 which plays a role with what he has previously characterized as Matheny's common output data. They seem to have absolutely no relevance to each other in this context.

The Examiner also points to col. 4, lines 1 and 28-32 as supporting the disclosure of specific output data. Col. 4, line 1 seems to be irrelevant. As far as lines 28-32 of col. 4 are concerned, they state the following: "Reward notice 260 and reward query 275 are conveyed in trigger messages, or 'triggers', broadcast to receivers of broadcast video. Such triggers generally instruct receivers to take a specific action to synchronize the content of a Web page with a broadcast television program." However, it is not clear what is "specific" about this signal, nor in contrast what is "common" about the other signal referred to by the Examiner.

The present claimed invention, such as recited in claim 1 for example, explicitly recites the following:

1. a plurality of supplementary, program-related outputs generated as a combination of common output data and specific output data,

2. the common output data being common to at least two of said outputs, and

3. the specific output data being unique to said outputs.

It remains unclear exactly what signal or portion of a signal in Matheny the Examiner considers to be common and likewise what signal is considered to be specific.

Moreover, it remains unclear where in Matheny the alleged "common output data" meets point no. 2 listed above, namely, that it is "common to at least two of the outputs" and, likewise, how Matheny's supposed "specific output data" is, in contrast, "unique to the outputs".

Thus, should the Examiner continue to maintain this rejection, he is respectfully requested to provide details which thoroughly explain his position and clearly relate the particular limitations claimed in the present application to particular features disclosed in Matheny. It is respectfully suggested that the Examiner consider at least the following questions:

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1. Which signal in Matheny is a program-related output?

2. What part of this signal is common to at least two outputs?

3. What part of this signal is unique to each output?

Moreover, it is respectfully submitted that the motivation provided by the Examiner is unclear, and to the extent that it can be understood, is inadequate. In particular, how would the modification of Holman based on Matheny "allow for flashier advertisements?" It may be relatively easy to superficially assert that modifying Holman based on Matheny is "obvious". However, at the circuitry level, Holman is designed to transmit the coupon information with the programming signal. The Examiner is respectfully requested to specifically identify how the circuitry of Holman could be modified based on Matheny. Which circuits would be eliminated? Which circuits would be inserted? Which circuits would e modified? If this is "obvious", it should be a straightforward task for the Examiner.

To summarize, it is respectfully submitted that the combination of references applied by the Examiner is inappropriate at least for failure to provide a proper motivation and/or suggestion for such a combination. Moreover, even if such a combination of references were to be made, the disclosure of Matheny is inadequate to obviate the present invention. Thus, it is respectfully submitted that all of the independent claims, each of which includes the distinctive features discussed above, is patentable over the combination of Holman and Matheny.

Patentability of dependent claims

The dependent claims are each dependent upon one of the above-discussed allowable independent claims. Thus, each of these dependent claims is allowable as well.
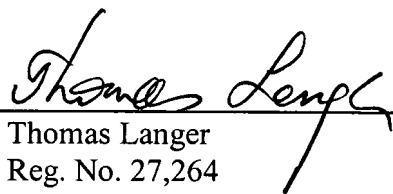
Conclusion

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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